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| EXAMINER | |
|---|---|
| LOWE, MICHAEL S | |

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| 3652 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | |
|---|---|---|
| **Office Action Summary** | **Application No.**<br>10/678,973 | **Applicant(s)**<br>WALKER ET AL. |
| | **Examiner**<br>M. Scott Lowe | **Art Unit**<br>3652 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on ______.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-37 is/are pending in the application.

4a) Of the above claim(s) ______ is/are withdrawn from consideration.

5)☐ Claim(s) ______ is/are allowed.

6)☒ Claim(s) 1-37 is/are rejected.

7)☐ Claim(s) ______ is/are objected to.

8)☐ Claim(s) ______ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 03 October 2003 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. ______.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/8/03.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ______ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: ______.

### *Information Disclosure Statement*

Foreign document WO 00/15538 was not considered since the document was not included with the application and could not be found by the examiner.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cylinder (for example see claims 20,31) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

Claims 1 & 22 are objected to because of the following informalities:

In claim 1 there is a space missing between "including" and "a" in line 5.

In claim 22, line 1, there should be "claim" before "20".

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,8,10,17,25,30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the sectional depth" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claims 10,30 recite the limitation "the sectional depth" in line 2. It is unclear whether this is the same sectional depth mentioned in claim 1 or a different one. For sake of examination it is assumed the applicant meant "another sectional depth".

Re claims 8,17, it is unclear whether applicant is attempting claim a method or apparatus as there is no structure added by the claim. See MPEP 2173.O5p(II).

Claim 25 recites the limitation "the sectional depth" in line 6. There is insufficient antecedent basis for this limitation in the claim.

## *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-37 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-37 of prior U.S. Patent No. 6,632,064. This is a double patenting rejection.

Claims 8,17 are rejected under 35 U.S.C. 101 because the claim overlaps two different statutory classes of invention (apparatus and process/method). See MPEP 2173.O5p(II).

## *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

> the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-19,25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vetter (DE 3710136A1) in view of Karall (US 6,202,217).

Re claim 1, Vetter teaches a rail (5,7-9) for use with a lifting fork 2, the lifting fork having a maximum working length between a distal end and a proximal end, a maximum width and a maximum sectional thickness, wherein the fork includes an upper working surface and a lower working surface, and wherein a portion of the upper working surface (see figures 3-10) has been removed to define a recess having the sectional depth. Vetter teaches having a recess in the rails and placing objects into these recesses in order to improve the rails (abstract) but is silent on vibration absorbing material. Karall teaches use of vibration absorbing material for any item in order to protect an object or person from vibrations (noise) (claim 1, column 4, lines 59-62, and "Background of the Invention").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Vetter by the teaching of Karall to have the rail include a length of vibration absorbing material dimensioned to at least substantially occupy the upper working surface recess wherein inherently the vibration absorbing material mitigates noise during loading and unloading operations of a container in order to protect an object or person from vibrations (noise).

Re claims 2-7,11-16,26-29, Vetter does not limit the dimensions of rail, recesses, and added items (5,7-9) and shows a variety of configurations in figures 3-10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Vetter inherently teaches any rail/recess dimension or configuration variations.

Re claims 8,17, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the recess in Vetter's rail subsequent to the manufacture of the fork in order to allow in to be adapted to actual working conditions and individual needs of the work sites in which it would have been used.

Re claims 9,18, Vetter does not limit the means of attachment of the rail. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the rail (5,7-9) fastened to a lifting fork by any known means in order to save the time and cost of developing a new way of securing rails.

Re claims 10,30, Vetter teaches (particularly in figure 5) a portion of the lower working surface being removed to define a recess having a sectional depth and further comprising a second rail (5,7-9). Vetter teaches having a recess in the rails and placing objects into these recesses in order to improve the rails (abstract) but is silent on vibration absorbing material. Karall teaches use of vibration absorbing material for any item in order to protect an object or person from vibrations (noise) (claim 1, column 4, lines 59-62, and "Background of the Invention").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Vetter by the teaching of Karall to have the rail include a length of vibration absorbing material dimensioned to at least substantially occupy the lower working surface recess wherein inherently the vibration absorbing material mitigates noise during loading and unloading operations of a container in order to protect an object or person from vibrations (noise).

Re claim 19, Vetter as already modified by Karall in claim 1, teaches at least one surface of the rail has a surface selected from the group consisting of a smooth surface, a corrugated surface, a cross-hatched surface, a surface having protrusions, and a surface having dimples (see figures of Karall).

Re claim 25, Vetter teaches a composite lifting fork 2 comprising:

a lifting fork 2 having a maximum working length between a distal end and a proximal end, a maximum width and a maximum sectional thickness , wherein the fork includes an upper working surface and a lower working surface, and wherein a portion of the upper working surface has been removed to define a first recess having a sectional depth (see figures 3-10); and

a first rail (5,7-9) attachable to the fork 2 and occupying the first recess. Vetter teaches having a recess in the rails and placing objects into these recesses in order to improve the rails (abstract) but is silent on vibration absorbing material. Karall teaches use of vibration absorbing material for any item in order to protect an object or person from vibrations (noise) (claim 1, column 4, lines 59-62, and “Background of the Invention”).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Vetter by the teaching of Karall to have the rail include a length of vibration absorbing material dimensioned to at least substantially occupy the upper working surface recess wherein inherently the vibration absorbing material mitigates noise during loading and unloading operations of a container in order to protect an object or person from vibrations (noise).

Claims 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karall (US 6,202,217) in view of Allen (US 5,221,176).

Re claim 20, Karall teaches a glove for use with any device including a lifting fork, the glove shaped to fit the device being protected in various shapes (claim 1, column 4, lines 59-62, and "Background of the Invention"). Allen teaches a lifting fork 15 having a progressive cross-sectional profile, a maximum working length between a distal end and a proximal end, a maximum width and a maximum sectional thickness, wherein the fork includes an upper working surface and a lower working surface and teaches further a need for covering the fork for safety. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have had the glove Karall sized as needed and shaped, in cylinder or any other known shape, to protect a lifting fork such as that of Allen for safety from vibration. Thus glove as modified would have a cylinder constructed from a vibration absorbing material having an inner progressive cross-sectional profile complementary to the cross-sectional profile of the fork and a length, and defining an interior volume having a width wherein the cylinder length less than or equal to the maximum working length of the fork.

Re claims 21-23, Karall does not limit the means of attachment of the glove. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the glove fastened to a lifting fork by any known means in order to save the time and cost of developing a new way of securing gloves.

Re claim 24, Karall teaches at least one surface of the rail has a surface selected from the group consisting of a smooth surface, a corrugated surface, a cross-hatched surface, a surface having protrusions, and a surface having dimples (see figures of Karall).

Claims 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vickers (US 3,692,335).

Re claim 31, Vickers teaches use of a sleeve insert 9 for a pocket-bearing container, the pocket 7,10 having an internal progressive cross section, including a height and an internal width at any given point along its length, the insert constructed from a vibration absorbing material (column 2, line 48) and having a progressive external cross section substantially complementary to the progressive cross section of the container pocket 7,10, and having a front portion periphery, a rear portion, an upper wall, a lower wall, an inside wall and an outside wall. Vickers teaches the insert used with any shaped device to reduce vibration (columns 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Vickers to be made cylindrical to allow use with a cylindrical device in order to reduce vibration.

Re claim 32, Vickers teaches a lip portion 9 extending from at least a portion of the front portion periphery wherein the lip portion extends at least unidirectionally beyond the external sectional dimensions of the container pocket 7,10 when the sleeve is inserted therein.

Re claim 33, Vickers teaches a lip portion 9 extending from all portions of the front portion periphery.

Re claims 34,35, Vickers teaches a lip portion 9 that is inherently a bumper (absorbs energy).

Re claim 36, Vickers does not limit the type of surface of the sleeve 9. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Vickers to have a surface selected from the group consisting of a smooth surface, a corrugated surface, a cross-hatched surface, a surface having protrusions, and a surface having dimples, or any other surface type in order to achieve a desired appearance for stylistic reasons.

Re claim 37, Vetter teaches a method for mitigating noise events generated during movement of a container 1 having at least one pocket 7,10, which is engageable by at least one lifting fork, comprising:

inserting a pocket liner 9 constructed from a vibration absorbing material into the at least one pocket 7,10. Vickers does not mention how the container 1 is lifted; however it is well known to use a forklift apparatus to move objects to protect workers from lifting injuries. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the container of Vickers lifted by a forklift apparatus to protect workers from lifting injuries.

## *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nelson (US 5,044,705) teaches vibration insulator for any shape cavity.

Campbell (US 4,275,771) teaches an insulating sleeve.

Chase (US 5,673,437) teaches a anti-vibration liner.

Martin (US 4,099,590) teaches a anti-vibration liner.

Hincks (US 5,560,451) teaches a anti-vibration liner.

Gembarosky (US 4,919,465) teaches a anti-vibration liner.

Johnston (US 4,717,188) teaches a anti-vibration liner.

Janssens (US 2001/0052550) teaches a anti-vibration liner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Scott Lowe whose telephone number is (571) 272-6929. The examiner can normally be reached on 6:30am-4:30pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

msl

Kathy Matecki

Kathy Matecki
Acting Director
TC 3600